

**REMARKS**

Claims 1-7, 9-15, 18 and 19 are pending herein. Claims 18 and 19 have been withdrawn by a Restriction Requirement.

By this Amendment, claims 1 and 11 are amended to more fully distinguish the invention over the cited references. No new matter is added by this Amendment. Claims 1 and 11 are merely amended to narrow a recited range limitation. Support for the language added to claims 1 and 11 may be found at, for example, page 14, first full paragraph, of the specification.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration since the amendments merely further narrow a recited limitation in the claims; and (c) place the application in better form for appeal, should an appeal be necessary. Entry of the amendments is thus respectfully requested.

**I. Election/Restriction Requirement**

The method claims of Group II (claims 18 and 19) include the limitations of the product claims of Group I. Thus, Applicants respectfully request that upon allowance of the product claims, the method claims be rejoined with the application and similarly allowed.

**II. Claim Rejections Under 35 U.S.C. §103(a)**

Claims 1, 2, 6, 7, 9-11 and 13 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 4,985,327 (hereinafter "Sakashita") in view of U.S. Patent No. 4,956,258 (hereinafter "Watanabe") and further in view of U.S. Patent No. 4,855,204 (hereinafter "Fujii").

Further, claims 3 and 4 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Sakashita in view of Watanabe, further in view of Fujii, and still further in view of U.S. Patent No. 5,922,500 (hereinafter "Iida").

Further, claims 5 and 12 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Sakashita in view of Watanabe, further in view of Fujii, and still further in view of *Handbook of Imaging Materials to Diamond* (hereinafter "Diamond"), pp. 179-181 and 222-224.

Finally, claims 14 and 15 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Sakashita in view of Watanabe, further in view of Fujii, and still further in view of U.S. Patent No. 5,994,015 (hereinafter "Vail").

Each of the foregoing rejections is respectfully traversed. Specifically, Applicants submit that Sakashita, alone or in combination with the cited references, fails to teach or suggest the subject matter of independent claims 1 and 11, and that the presently claimed invention achieves results not expected from the combined teachings of the cited references so as to not have been obvious to one of ordinary skill in the art.

In the July 16, 2003 Office Action (paper no. 11), the Patent Office referenced the Abstract of Sakashita and alleged that Sakashita teaches a toner that has a size distribution of 17-60% by number of non-magnetic toner particles of 5  $\mu\text{m}$  or smaller. The Patent Office further referenced table 5 and alleged that Sakashita discloses 17.2% of toner particles by number have a size of 4.00  $\mu\text{m}$  or below.

However, nowhere does Sakashita teach or suggest a ratio of white color toner particles having a particle diameter of no greater than 4  $\mu\text{m}$  is 6 to 16% by number with respect to the total number of the white toner particles, as recited in each of claims 1 and 11.

Instead, Sakashita teaches the non-magnetic toner particles having a particle size of 5 microns or smaller are contained in an amount of 17-60% by number, preferably 25-50% by

number, more preferably 30-50% by number. Sakashita further teaches that if the amount of non-magnetic toner particles is smaller than 17% by number, the toner particles effective in enhancing image quality is insufficient. See col. 6, lines 32-45 of Sakashita. Thus, Sakashita teaches away from a ratio of white color toner particles having a particle diameter of no greater than 4  $\mu\text{m}$  that is 6 to 16% by number with respect to the total number of the white toner particles, as required by claims 1 and 11.

The Patent Office further acknowledged that Sakashita does not disclose a white colorant or that the colorant is present in an amount of 20 wt %. However, the Patent Office alleges that Watanabe teaches that white is a known pigment colorant for toners and is known as an alternative in the art and Fujii teaches specific features pertinent to the formulation of white toners.

Contrary to the assertion made by the Patent Office, Sakashita, Watanabe and Fujii, alone or in combination, would not have led one of ordinary skill in the art to the invention of claims 1 and 11. Specifically, nowhere do the cited references, alone or in combination, teach or suggest a white color toner particle containing at least a binder resin and a colorant, with the particle having a volume average particle diameter of no greater than 14  $\mu\text{m}$  and a concentration of the colorant being 20 to 50% by weight with respect to the binder resin, wherein a ratio of white color toner particles having a particle diameter of no greater than 4  $\mu\text{m}$  is 6 to 16% by number with respect to the total number of the white toner particles, as recited by each of claims 1 and 11.

Further, as evidenced by the previously submitted Rule 132 Declarations, when used in a single-layer constitution, the white color toner of the present invention and the cyan toner of Sakashita provide almost similar values in shielding property. However, when used in a two-layer constitution in which the white color toner or the cyan toner is superimposed on the

black toner layer, the white color toner of the present invention provides excellent results in shielding property (higher transmission density) as compared to the toner of Sakashita.

Nothing in the references cited by the Patent Office (i.e., U.S. Patent No. 4,956,258 to Watanabe, U.S. Patent No. 4,855,204 to Fujii, *Handbook of Imaging Materials* to Diamond, pp. 179-181 and 222-224, or U.S. Patent No. 5,994,015 to Vail), alone or in combination, remedy the deficiencies of Sakashita discussed above. More specifically, nothing in the cited references, alone or in combination, teaches or suggests (1) a concentration of the colorant being 20 to 50% by weight with respect to the binder resin, wherein a ratio of white color toner particles having a particle diameter of no greater than 4  $\mu$ m is 6 to 16% by number with respect to the total number of the white toner particles, as recited by each of claims 1 and 11; or (2) the unexpected properties associated with the white toner of the present invention. One of ordinary skill in the art thus would not have found the invention obvious from the teachings of the references cited in the Office Action.

For the foregoing reasons, Applicants submit that the rejection of claims 1 and 11 and depending claims 2-7, 9, 10, and 12-15 have been overcome. Reconsideration and withdrawal of the rejections is thus respectfully requested.

### **III. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-7, 9-15, 18 and 19 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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